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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/564,322

06/26/2006

Kai Desinger

3444

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7590

04/21/2011

Max Moskowitz
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EXAMINER

SCOTT, AMANDA L

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

04/21/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/564,322 | Applicant(s) DESINGER ET AL. | |
| | Examiner Amanda Scott | Art Unit 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/25/2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/01/2010; 01/22/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on (RCE:02/12/2010) 02/25/2011(amended claims) has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Müller (US 6,379,349) in view of Desinger (US6,723,094).

Regarding claim 1, Müller discloses a surgical probe comprising: a handle (5) and a shaft (2, view figure 1) which is connected to the handle; wherein the shaft comprises: a proximal electrode (4); a distal electrode (3); wherein the proximal electrode is nearer to the handle than the distal electrode, an insulator (6); and a hollow body extending from the handle (view figures 1 and 2a, figure 1 shows the overall probe

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and figure 2 shows the hollow body, the distal end of the hollow body integrally forming the distal electrode, with the hollow body being distally closed, made of metal and electrically conductive (view figure 2); wherein the insulator(6) electrically insulates the proximal electrode from the distal electrode (view figure 2a), with the insulator comprising an insulating layer supported on the hollow body and positioned in a radial direction between the hollow body and the proximal electrode; the hollow body further comprising a fluid passage in the interior thereof, configured for passage of a cooling fluid therein (column 6, lines 4-19); wherein the proximal and distal electrodes comprise an outer surface of the shaft and are axially separated from each other by the insulator (view figures 1 and 2); wherein the probe is configured to have a mechanical strength, rigidity and perforation capability that permits insertion of the shaft into the body tissue (the device is used to puncture tissue, column 5, lines 39-41), but fails to disclose wherein the hollow body comprises a portion of smaller outside diameter and a portion of larger outside diameter, wherein the portion of larger outside diameter comprises the distal electrode and wherein the portion of smaller outside diameter supports the proximal electrode and the insulator thereon and that the outside diameter of the two electrodes and the outside diameter of the insulator are approximately equal. However, Desinger discloses a surgical probe wherein the hollow body comprises a larger outside diameter and a smaller outside diameter where the distal portion has a larger diameter than that of the proximal portion and that the outside diameter of the two electrodes (2,4) and the outside diameter of the insulator (50) are approximately equal (shown in reproduced figure 3). It would have been obvious to one having ordinary skill in the art

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at the time the invention was made to have the surgical probe of Müller have varying diameters as shown by Desinger as well as having the diameter along the length of the shaft be continuous. Doing so would allow the probe to be inserted into body tissue by having a smooth external surface as shown by Desinger (column 2, lines 64-67).

Regarding claims 2 and 3, Müller and Desinger disclose a surgical probe as set forth in claim 1, wherein the insulating layer of the insulator is arranged between the hollow body and the proximal electrode and at the interface between the hollow body and the insulator (Desinger: view figure 3; column 8, line 56-column 9, line 11; shrink tubes).

Regarding claim 4, Müller and Desinger disclose a surgical probe as set forth in claim 1, wherein the proximal electrode is formed by a metal tube of a diameter which is substantially equal over its length and of substantially equal wall thickness (Desinger: view figure 3).

Regarding claim 6, Müller discloses a surgical probe as set forth in claim 1, wherein the fluid passage extends in the hollow body to the closed end thereof and is of a diameter which is substantially equal throughout (view figure 2a, dotted tube line).

Regarding claim 7, Müller discloses a surgical probe as set forth in claim 1, wherein the hollow body is shaped to a point at its distal end (view figure 1).

Regarding claim 8, Müller and Desinger disclose a surgical probe as set forth in claim 1, wherein in the region of the distal electrode the hollow body is of an outside diameter which is approximately equal to the outside diameter of the proximal electrode or of the insulator (Desinger: view figure 3).

Regarding claim 10, Müller discloses a surgical probe as set forth in claim 1, wherein a hose is in the interior of the fluid passage, with a mouth of the hose opening in the proximity of the closed distal end of the fluid passage, which hose is so arranged and connected that a cooling fluid is to be passed through the hose into the proximity of the distal end of the fluid passage, there issues from the mouth opening of the hose and can flow back between the hose and the wall of the fluid passage to the proximal end of the shaft (column 6, lines 4-19 and column 7, lines 8-56).

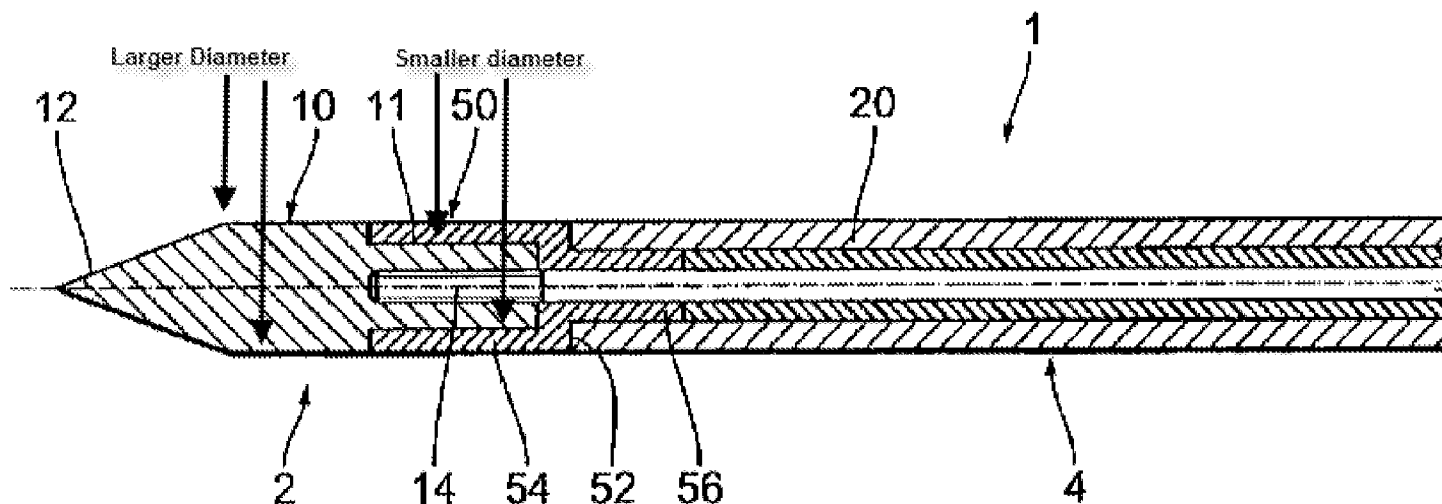


Fig. 3

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Müller and Desinger as applied to claim 1 above, and further in view of Crites et al. (3,568,660).

Regarding claim 11, Müller and Desinger disclose the invention set forth above but fail to disclose that at its proximal end the shaft is connected to the handle and is there partially embedded in sealing material in such a way that the tube forming the

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proximal electrode is completely embedded at its proximal end in the sealing material while the proximal end of the hollow body projects from the sealing material.

However, Crites et al. teach a handle fitted over the cylinder and an electrically insulating epoxy applied over the exposed surface of the cylinder and a surface of the handle with the proximal ends of the conductors soldered to the conductors (column 5, lines 31-46).

It would have been obvious to one of ordinary skill in the hand-held electrosurgical art to have modified Müller and Desinger with electrically insulating epoxy applied over the exposed surface of the cylinder and a surface of the handle with the proximal ends of the conductors soldered to the conductors as taught by Crites et al. because it would have enabled the proximal electrode to be preferably electrically contacted within the sealing material.

Regarding claim 12, Müller and Desinger disclose the invention set forth above but fail to teach that the proximal electrode is electrically contacted within the sealing material.

However, Crites et al. teach the proximal ends of the conductors are soldered to the conductors (column 5, lines 45-46). It would have been obvious to one of ordinary skill in the hand-held electrosurgical art to have modified Müller and Desinger with proximally soldered ends as taught by Crites et al. because it would have enabled the proximal electrode to be electrically contacted within the sealing material.

Response to Arguments

Applicant's arguments with respect to claims 1-8 and 10-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Scott whose telephone number is (571)270-7103. The examiner can normally be reached on Monday thru Thursday, 8:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./
Examiner, Art Unit 3739

/Linda C Dvorak/
Supervisory Patent Examiner, Art
Unit 3739

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